

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85472044
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	
Argument and analysis per the PDF document submitted in the "evidence" field.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_38886218-133115996_ion_Response_II_-_THE_SLANTS_-_Ser_No_85472044_Dec_10_2012.pdf
CONVERTED PDF FILE(S) (9 pages)	\\TICRS\EXPORT16\IMAGEOUT16\854\720\85472044\xml4\RFR0002.JPG
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DESCRIPTION OF EVIDENCE FILE	Argument and analysis.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/s/
SIGNATORY'S NAME	Ronald Coleman

SIGNATORY'S POSITION	Attorney of record, New York bar member
SIGNATORY'S PHONE NUMBER	2126958100
DATE SIGNED	12/10/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Dec 10 13:38:28 EST 2012
TEAS STAMP	USPTO/RFR-38.88.62.18-201 21210133828397954-8547204 4-490e6db1ea6fcc62ea5d77a a7aaa5bf6940-N/A-N/A-2012 1210133115996173

PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85472044** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Argument and analysis per the PDF document submitted in the "evidence" field.

EVIDENCE

Evidence in the nature of Argument and analysis. has been attached.

Original PDF file:

[evi_38886218-133115996_ion Response II - THE SLANTS -
Ser. No. 85472044 Dec 10 2012.pdf](#)

Converted PDF file(s) (9 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /s/ Date: 12/10/2012

Signatory's Name: Ronald Coleman

Signatory's Position: Attorney of record, New York bar member

Signatory's Phone Number: 2126958100

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85472044

Internet Transmission Date: Mon Dec 10 13:38:28 EST 2012

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Simon Shiao Tam

Mark: THE SLANTS

Serial No.: 85472044

Filing Date: March 5, 2010

Examining Attorney: Mark Shiner

Law Office: 102

RESPONSE TO OFFICE ACTION DATED JUNE 20, 2012

Applicant submits this response to the Office Action dated June 20, 2012, in which the Examining Attorney reaffirms the refusal to register of Applicant's standard character mark on the grounds that the mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols pursuant to 15 U.S.C. §1052(a). In response, Applicant respectfully submits the following:

I. THE EXAMINING ATTORNEY HAS APPLIED A NOVEL PER SE RULE AGAINST REGISTRATION OF "THE SLANTS" BY THIS APPLICANT THAT IS NOT SUPPORTABLE BY EXISTING LAW OR PUBLIC POLICY.

In his response to the initial Office Action, Applicant acknowledged that, where an application, on its face, raises a question of disparagement under 15 U.S.C. §1052(a), an examining attorney may acquire and consider materials from outside the application in order to assess whether such a mark is regarded as such by the affected group as used. The second Office Action disregards this acknowledgement, however, as well as Applicant's related discussion of *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994), stating as follows:

[A] proper consideration of the application is to determine how the mark would be perceived based upon how it is used in the marketplace. To hold otherwise would be to allow the clever construction of an application to avoid a disparaging finding, resulting in expensive opposition and cancellation proceedings by affected third-parties.

Here, the evidence is uncontested that applicant is a founding member of a band (The Slants) that is self described as being composed of members of Asian descent. . . . Thus, the association of the term SLANTS with those of Asian descent is evidenced by how the applicant uses the mark – **as the name of an all Asian-American band**. Further, applicant (and his fellow band members) has repeatedly indicated that the name THE SLANTS is in fact a direct reference to the derogatory meaning of the term and in fact, they are embracing the derogatory meaning of the term. One of the members of the band is quoted as stating . . .

[FN 1] Notably, this is not applicant’s first time before the United States Patent and Trademark Office seeking registration of the mark THE SLANTS for live musical performances. . . .

Office Action at 2 (emphasis added). The arrangement of these excerpts appears to reveal the underlying basis for the refusal: While nothing disparaging about the use of THE SLANTS is presented in the application, **this particular** applicant is not entitled to a registration because he and his “all Asian-American band” have, in the past, used the mark in manner deemed disparaging. Under this standard, no application by this Applicant for THE SLANTS can overcome the stain of Applicant’s use of that mark in connection with services provided by what is revealed – by Internet articles and a previous application – to have been an all Asian-American band.

This seems, perhaps, to be a novel extension of *res judicata* to the trademark registration process. Of course, merely because the same person applies for registration of a trademark superficially like one for which he was previously denied registration does not mean that *res judicata* bars a similar new application by the same applicant. *Sheffield-King Milling Co. v. Theopold-Reid Co.*, 269 F. 716 (D.C. Cir. 1921). Here, while the

applications are different, the trademark is, admittedly, not merely superficially similar, but the same. But it is not the sameness of the **mark** in the two applications on which the Examining Attorney relies in refusing registration. It is the sameness of the **Applicant**. The refusal here is not based on the trademark being a “bad word”; “slant” is a word with multiple meanings, of which the ethnic slur on which the refusal is purportedly based is attenuated, to say the least.¹ The refusal, rather, is based on Applicant’s past “bad use” and presumptively bad intention respecting this neutral word, as indicated by material from outside the Application.

This appears to amount to a *res judicata*–like rule barring registration of this mark by this Applicant for all time. Concomitantly, because the Examining Attorney’s rationale for refusal is the external record of Simon Shiao Tam’s use of the mark – the goods and services described in the actual Application being, per the Office Action, of little relevance – anyone else on earth who submitted the identical application for THE SLANTS could expect registration to be allowed. This result would be a surprising reading of 15 U.S.C. §1052(a).

Applicant acknowledges that a “No SLANTS Trademark for Simon Tam” rule may be preferable to other disparagement-based rationales that might seem more “flexible” but which would raise even more problems. For example, the Office Action eliminates any consideration of the possibility, consistent with the proof of use in the Application, that Applicant’s use of THE SLANTS at the time of the application is different from the “disparaging” manner in which he used it in the past. An Examining

¹ Indeed, Applicant’s response to the first Office Action demonstrated that a trademark such as THE SLANTS, in contrast to the famously disparaging marks consisting of derisive ethnic slurs, should be registered if its primary meaning is non-disparaging. The Office Action makes no serious attempt at rebutting this showing. (See Section II.)

Attorney cannot be expected to determine, whether based on the four corners of the application or dogged Internet surfing, the quality and extent to which an applicant has repented of past trademark “misuse.” Hence a “one strike and you’re out” approach has a certain elegance to it.

A per se rule of refusal for any registration of THE SLANTS by Applicant may also avoid an even more troubling outcome, considering that the refusal is based on Applicant’s use of the mark in connection with an “all Asian-American” band. Section 1052(a) is silent as to just how many Asians it takes to make a “Slant” unregistrable, but a per se rule prohibiting registration by Simon Tam has the virtue of absolving the Commissioner of Trademarks from involvement with questions such as:

- How many Asian-American members of The Slants should be replaced with non-Asians to secure the racial composition the Lanham Act requires before a registration may issue?
- Is use of THE SLANTS by an all Asian-American band disparaging under 15 U.S.C. §1052(a) only if the band members are “full blooded” Asian-Americans, or is use of the mark by “mixed race” musicians also a bar to registration?²

Because under the rationale of the refusal the past disparaging conduct of Applicant, i.e., his use of THE SLANTS while being Asian, is forever outcome-determinative, the Commissioner can defer such strict delineation of which trademark registrations may be

² Naturally there is no solution in this regard for Applicant himself, who cannot change his own ethnic identity. By analogy, however, based on the Office Action, it may be the case that Applicant could reduce the disparaging nature of his own inherently Asian use of THE SLANTS by utilizing fewer “Asian” icons and symbols in his performances and promotion of the band. Because, however, the refusal is premised on unacceptable conduct by Applicant that has already occurred and been made a matter of record, this, too, is a judgment that the Patent and Trademark Office need not involve itself with.

allowed, and which refused, based on the ethnic eligibility of an applicant or others with whom he uses the mark in commerce.

Similarly, Applicant acknowledges that problem inherent in the possibility that, once in the possession of a registration for THE SLANTS, Applicant might just go ahead and hire Asian musicians to join The Slants again, thus offending the racial strictures of the Lanham Act. A bright-line rule forbidding registration of THE SLANTS by this Applicant, no matter how inoffensive his use of the mark at present, also avoids the possibility that Applicant might get a registration and then revert to a level of Asian-themed artistic expression prohibited by 15 U.S.C. §1052(a).³

Applicant submits, however, that none of the foregoing “problems” involving how this particular applicant makes use of this mark, and with whom, need be addressed at all by the Commissioner of Trademarks if the Examining Attorney will take stock of the implications of this refusal and reconsider whether 15 U.S.C. §1052(a) bars Applicant from registering the word “slant” as his band’s trademark. As the above, largely tongue in cheek, is meant to suggest, the reasoning of the Office Action is premised entirely on outside evidence of Applicant’s aggressively Asian-themed artistic and commercial identity as used in the past with the mark. As a corollary, an applicant with no Asian aspect to its identity whatsoever would be allowed registration on the same exact Application, unless “slants” is to be regarded in and of itself – **without reference to a specific applicant** – as a bona fide term of ethnic disparagement with no redeeming registrable qualities.

³ The question raised by a bona fide assignment of such a registration, along with the goodwill in the mark, by a non-disparaging registrant to a third party – or even Applicant himself – who might not sufficiently abide the racial-content parameters the Office Action finds in 15 U.S.C. §1052(a) remains, however, unresolved by the Applicant-specific approach relied on by the Examining Attorney.

As set forth below, however, neither the first nor the second Office Action demonstrates that THE SLANTS is an inherently offensive ethnic slur. For this reason, the ethnic identity of the Applicant, and the extent to which he associates in his use of the mark with other Asians or the degree to which he makes use of his own cultural heritage, should be of no relevance whatsoever in the consideration of this registration application, and the registration should be allowed.

II. THE EXAMINING ATTORNEY HAS NOT ADEQUATELY ADDRESSED APPLICANT'S FACTUAL DEMONSTRATION THAT IN ITS OWN RIGHT, "THE SLANTS" IS A TERM THAT IS AMENABLE TO AND COMMONLY ASSOCIATED WITH NEUTRAL, NON-DISPARAGING USES.

The premise of the previous section is that, unlike other ethnic-slur refusals to register on which the Office Action relies as precedent, here the refusal is based not on the trademark being inherently disparaging, but on "disparaging use" presumed, improperly, to be an inherent characteristic of the Applicant. The Office Action claims, however, that the mark is in fact inherently offensive to Asians. It is submitted, however, that the Examining Attorney has not demonstrated the factual validity of that proposition as required under the TMEP.

The initial Office Action cited several decisions upholding refusals of known ethnic slurs, determined to be such either by the marks' dominant meanings or based on evidence contained in the respective applications. Here, in contrast, the Office Action has "imported" one specific applicant's **use** of an otherwise neutral word, "slants," as grounds for a determination despite the lack of disparaging use of the mark in the Application, Applicant's use of the term is necessarily disparaging and not entitled to allowance. Applicant noted the absence of precedent for such an analysis. The Office

Action declines the invitation, or challenge, by the Applicant to demonstrate that the TTAB or the courts have upheld a refusal based solely on external evidence concerning, not communal reaction to a term in general, but to **a given Applicant's** historic use of a mark. Instead, rather ironically, the second Office Action repeats the argument *ad hominem*, i.e., that any use of the mark THE SLANTS by this Applicant is per se scandalous, because **his** use of the mark in circumstances not reflected in the Application but relied on as grounds for refusal in a previous application has been deemed offensive by third parties. It is submitted that this approach to determining whether a mark is disparaging is not supported by the law.

The second Office Action fails to seriously address its reliance on the dubious authority of “special dictionaries” by demonstrating that they are recognized or accepted as reliable reference works by academia, the bench or any other objective and authoritative source. The entire response to Applicant’s four pages of closely-reasoned analysis on this topic is as follows:

Applicant argues that the dictionaries referenced are not “actual” dictionaries. This statement is incredulous on its face [*sic*]. Specialized dictionaries are no less “actual” dictionaries than generalized dictionaries. In fact, many of the dictionaries and reference materials are published by large scale publishing houses, such as Harper Collins.

Applicant’s argument, it is submitted, was not at all as facile as the above characterization suggests, and the Examining Attorney should not be incredulous about it all. In fact, the second Office Action ignores Applicant’s overwhelming proof of contrary dictionary definitions, and indeed fails to address its own glaring failure to comply with TMEP Rule 710.01 in so ignoring them.⁴ And it makes no attempt to

⁴ “In appropriate cases, the examining attorney may also present evidence that may appear contrary to the USPTO’s position, with an appropriate explanation as to why this evidence was not considered

address the fact, noted by Applicant, that even the definition of “slant” in the one **standard** dictionary on which the Office Action does rely does not define “slant” as an ethnic slur until its **fourth** definition.

Significantly, the Examining Attorney also declines to make any effort to rebut the problem inherent in the use of lists or “special dictionaries” cataloguing supposed ethnic slurs which, by definition, can only “confirm” the claim that “slant” is an ethnic slur (“affirming the consequent”). Again, finding that a word is listed in such a collection provides no insight at all into whether the disparaging sense of the word – whether the word is “slant,” “banana,” “bumblebee” or “cabdriver” (all found in the source on which the Office Action relies) – is the word’s primary, or even one of its primary, senses as commonly understood. The Office Action does not provide authority for the dubious suggestion that a work is entitled to deference as a source of “dictionary definitions” under the TMEP merely because it was published by a “large scale publishing house.”

III. CONCLUSION

In light of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw his refusal to register Applicant’s mark and publish Applicant’s mark on the Principal Register.

Respectfully submitted,

Simon Shiao Tam

By: 
Ronald D. Coleman

GOETZ FITZPATRICK, LLP

controlling. In some cases, this may foreclose objections from an applicant and present a more complete picture if there is an appeal. *Cf. In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987).” TMEP Rule 710.01.

One Penn Plaza, 44th Floor
New York, New York 10119
(212) 695-8100
Attorneys for Applicant

Dated: December 10, 2012